

REMARKS/ARGUMENTS

The above-identified patent application has been reviewed in light of the Examiner's Action dated August 27, 2007. Claim 7 has been canceled. Claims 5, 8 and 21-24 are now pending. The Examiner has objected to the specification and the drawings. Claims 5, 7, 12 and 13 have been rejected under 35 U.S.C. §112 as being indefinite. Claims 5 and 8 have been rejected under 35 U.S.C. §102(b) as being anticipated by newly-cited U.S. Patent No. 4,470,437 to Rabinovich ("Rabinovich"). Claims 5, 7, 8 and 21-24 have been rejected under 35 USC §103 as being unpatentable over a combination of previously cited Minnick and Ball.

Finality of the Present Office Action

Applicant traverses the finality of the August 27, 2007 Office Action Summary. The Examiner is well aware that "[u]nder present practice, second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR §1.97(c). MPEP §706.07(a) (*emphasis added*). A new ground of rejection was based on newly-cited Rabinovich. In the non-final March 27, 2007 Office Action Summary the Examiner indicated that dependent Claims 6 and 9 would be allowable if rewritten in independent form. Applicant adopted the Examiner's suggestion and amended Independent Claim 5 by adding the subject matter of Claim 6. The subject matter of Claim 9 was added to the subject matter of Claim 5 to form new Claim 21. Therefore, no substantive amendments were made. In addition, no information disclosure statement

under 37 CFR §1.97(c) was filed subsequent to the Amendment and Response filed July 26, 2007. Thus it is requested that the Examiner remove the finality of the present office action. To not do so would irreparably harm Applicant by, for example, forcing the preparation of a Petition or an Appeal to address this issue. Section 706.07 of the MPEP states, in relevant part, "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Furthermore, Section 706.07(e) of the MPEP provides in relevant part " The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable ..., then the final rejection should be withdrawn." If Examiner refuses to withdraw the finality of the instant office action, it is asked that all amendments presented herein be entered into the official record to place the instant application in better form for appeal.

Objections to the Drawings

The Examiner has disapproved the drawing corrections presented in the Amendment and Response filed July 26, 2007, but states that the proposed drawing changes discussed on page 7 of the said Amendment and Response would be acceptable if filed with a complying drawing amendment. Applicant invites the Examiner to re-review the Amendment and Response filed July

26, 2007 that included an Annotated Drawing Sheet and a Replacement Sheet that clearly shows the proposed drawing amendments. The Examiner can review the Amendment and Response filed July 26, 2007 on the USPTO's Patent Application Information Retrieval (PAIR) system. In order to aid the Examiner, the drawing amendments in question are shown in Annotated and Replacement Sheets included herewith. If the proposed drawing corrections to Figs. 2 and 3 previously presented in the Amendment and response filed July 26, 2007 are not those referred to as the "Complying Amendment", Applicant respectfully requests that the Examiner be more specific.

Objections to the Specification

The Examiner has stated that the Applicant did not identify the amendment that removed reference characters 37A, 37B and 61. Applicant invites the Examiner to re-review the Amendment and Response filed July 26, 2007 that clearly stated that "[t]he disclosure for reference numbers "37A", "37B", "56" and "61" was removed in an Office Action Response [of] **June 27, 2006.**" (*Emphasis added*). The Examiner can find the Amendment and Response filed June 27, 2006 on the PAIR system. In order to aid the Examiner in his review, excerpts of the June 27, 2006 Amendment and Response are included below:

Please replace the first two paragraphs at page 4, beginning with line 7 and continuing to line 25 with the following amended paragraph:

With reference to Figs. 2 and 3, a cap 52 has an outer face 54 which has a cylindrical body 60 which has interior threads 62 and which are adapted to mate with the threads 31 of ~~port 30~~ port 30 leg 37A (Fig. 2). An O-ring (not shown) may be used on the cap 52 to help seal the cap 52. The cap 52 also has an annular flange 64 that extends radially outwardly from the open end of the cylindrical body 60. A thin sealing membrane 66 is affixed to the face 54 (Fig. 2) of cap 52 so as to seal the aperture 56- in the cap 52 when it is screwed into ~~onto~~ the threads 31 so that the cap 52 can be effectively sealed against the port 30 leg 37A. It should be appreciated that though this

embodiment show a cap 52 that screws onto threads 31 that are on the outside of pipe 34, the cap 52 in an alternate embodiment could screw into interior threads of pipe 34.

In operation, the cap 52 can either be removed from the port 30 leg 37A, or the thin sealing membrane 66 can be cut away so as to permit the attachment of the conventional overflow mechanisms.

At page 4, after line 26, and before line 27, please delete the following paragraphs added in a previous office action:

~~Referring to Figs. 1-3, in one embodiment, an overflow system for a bathtub 18 which has a bottom 26, and adjacent sidewalls 22 and endwalls 24, a drain port 28 in the bottom 26, and an overflow port 30 in one of the endwalls 24. A drain pipe 34 adapted to be in communication with said drain port 28 and said overflow port 30. The drain pipe 34 having an inverted L-shape, including a horizontal leg 37A extending into and through the overflow port 30 of the bathtub 18, and a vertical leg 37B extending downwardly for connection to a fluid drain system 38. Threads 31 are located on the horizontal leg 37A extending through the overflow port 30. A cap 52 is threadably mounted on an end of the horizontal leg 37A extending through the overflow port 30. A cap 52 has an opening in its circular planar end 54 (also referred to herein as face 54), with a thin flexible sealing membrane 66 secured to the cap 52 and extending over the opening 56 in the circular planar end 54.~~

~~In another embodiment, a plumbing test system includes a pipe 34 having a first exposed end 37A and second end 37B in communication with a fluid source, wherein the first end 37A comprises an externally threaded portion 31. The cap assembly~~

~~61 includes a cap 52 having an opening 56 in a planar end 54, with a sealing member 66 secured to the cap 52 and extending over the opening 56 in the planar end. The cap 52 is threadably mounted on the externally threaded portion 31 of the first end 37A and wherein a portion of the cap assembly 61 is composed of a material capable of sealing the first end 37A when the cap 52 is threaded onto the first end 37A.~~

The Examiner has also stated that antecedent basis for “threads” included on an “interior diameter” of Claim 7 is lacking, an objection that could have been made in the Office Action Summary dated March 27, 2007. Applicant asserts that the Examiner’s failure to previously raise this objection is an admission that one skilled in the art would not find Claim 7 indefinite. For example, would not a failure to specifically address an Examiner’s assertion be subsequently treated by the Examiner as an admission that said assertion, no matter how unsound, be true? Nevertheless, in order to facilitate prosecution, Claim 7 has been canceled.

The Examiner objected to Claim 21 as not including antecedent basis for the claim term “second annular flange”. Again, the Examiner could have made this objection previously since the objected-to language was first presented in an Amendment and Response filed February 14, 2007. Nevertheless, the specification and figures have been amended to address this objection. No new matter has been added by this amendment because the second annular flange was provided in Fig. 3 as originally filed.

Claim rejections - 35 USC § 112

Claims 5, 7, 12 and 13 have been rejected as being indefinite. The Examiner is apparently unclear as to the relationship between the “flange” 64 and the “face” 54 as claimed. As one of skill would appreciate a flange is “a protruding rim or edge used to strengthen and object or hold it in place.” The American Heritage Dictionary of the English Language (1983). “Face” is most aptly defined in light of the devices described in the instant application as a “a planar surface bounding

a solid.” *Id.* Applicant, thus, asserts that the face is a part of the flange and that one of skill in the art would not be confused by the claim language.

The Examiner also stated that Claim 7 is unclear. As outlined above, Claim 7 has been canceled, thereby rendering the rejection moot.

Finally, the Examiner has stated that Claims 12 and 13 are indefinite. Applicant directs Examiner’s attention to the Amendment and Response filed July 26, 2007 wherein Claims 12 and 13 were cancelled. Applicant believes this rejection to be erroneous.

Claim rejections - 35 USC §102

The Examiner has rejected Claims 5 and 8 as being anticipated by newly-cited Rabinovich. This rejection is traversed since Rabinovich does not teach each and every one of the claimed elements. The claims, among other things, succinctly require a cap that is threadingly engaged to an overflow pipe. Rabinovich does not show such a cap. More specifically, the Examiner has equated a cap 82 (it is believed that the Examiner meant (87)) with the cap as claimed. The cap (87) of Rabinovich does not include threads and, thus, can not be threadingly engaged to an overflow port. Conversely, the “cap” of Rabinovich is simply a cup that is inserted into a bore provided in a tank wherein the insertion of an emergency drain device (10), which is threadingly inserted into the port, displaces the cup. Once the cup is displaced, a flow path from inside the tank through the emergency drain device is provided. Various other elements, such as a cap “having a cylindrical body bounded by an outer face wherein the cylindrical body has interior threads and angular flange that extends radially outward from an open end of the cylindrical body” are also absent in

Rabinovich. Further, the cup (87) of Rabinovich does not include a membrane as claimed. The Examiner has grossly misinterpreted Rabinovich to allegedly include all of the elements of Claim 5, and thus dependent Claim 8, in an attempt to justify holding the present action final. Accordingly, it is requested that this rejection related to Rabinovich be withdrawn since the reference clearly does not include each and every element of the claimed invention as required by 35 U.S.C. §102.

Claim rejections - 35 USC § 103

The Examiner has rejected Claims 5, 7, 8 and 21-24 as being obvious in view of a combination of Minnick and Ball. The Examiner indicated in an Office Action dated March 27, 2007 that previously cancelled Claims 6 and 9 would be allowable if rewritten in independent form. In an Amendment and Response filed July 26, 2007, Applicant adopted the Examiner's suggestion and added to independent Claim 5 the elements of previously cancelled Claim 6, and the elements of Claims 5 and previously cancelled claim 9 to form new Claim 21. Therefore, Claims 5 and 21, and their respective dependents, should have been held allowable. The Examiner reversed his opinion supposedly in light of Applicant's arguments. Applicant, however, did not make any arguments related to the combination of Ball and Minnick - the Examiner's suggestion was simply followed without comment. Thus, Applicant demands that Examiner withdraw this clearly improper rejection, since, as stated by the Examiner in the Office Action dated March 27, 2007, that elements now found in independent Claims 5 and 21 render the claims allowable over the combination of Ball and Minnick.

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Conclusion

Based at least upon the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. Thus it is respectfully requested that the Examiner contact the undersigned at his earliest convenience if any concerns exist with respect to this case.

Respectfully submitted,

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